

REMARKS

In the Office Action¹, the Examiner rejected claims 3 and 7 under 35 U.S.C. § 112, second paragraph; rejected claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,873,071 to Ferstenberg et al. ("*Ferstenberg*"); and rejected claims 6-9 under 35 U.S.C. § 103(a) as being unpatentable over *Ferstenberg*.

Applicants have amended claims 1, 3, 6, 7, and 9. Claims 1-9 remain pending.

The Examiner rejected claims 3 and 7 under 35 U.S.C. § 112, second paragraph, because the claims "fail[] to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (Office Action at page 2).

The Examiner states, "there is no antecedent basis for 'the information process system'" in claim 3 (Office Action at page 2). Applicants have amended claim 3 to recite "the information processing system" instead of "the information process system."

The Examiner states, "there is no antecedent basis for 'the purchase-and-sale contract'" in claim 7 (Office Action at page 2). Applicants have amended claim 7 to not recite "the purchase-and-sale contract."

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3 and 7 under 35 U.S.C. § 112, second paragraph.

Applicants respectfully traverse the rejection of claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by *Ferstenberg*.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1, as amended, recites an information processing system, including, for example, “an escrow system management server for generating escrow processing information about the purchase-and-sale contract for an escrow agent and transmitting the escrow processing information to the escrow agent.” *Ferstenberg* does not disclose at least the claimed escrow system management server.

Ferstenberg discloses a “computer system[] that facilitates an automatic exchange of commodities between users according to the user’s goals” (col. 1, lines 6-10). The users are “represented by electronic agents . . . that interact with an electronic intermediary . . . the agents conduct negotiations by exchanging electronic messages with the intermediary” (col. 12, lines 37-50). *Ferstenberg* does not disclose any other parties that are involved except for the users and the intermediary (see Fig. 4). Therefore, *Ferstenberg* does not disclose “an escrow system management server for generating escrow processing information for an escrow agent . . . and transmitting the escrow processing information to an escrow agent,” as recited in claim 1.

Accordingly, *Ferstenberg* cannot anticipate claim 1. Claims 2-5 depend from claim 1, and are thus allowable over *Ferstenberg*, for at least the same reasons as claim 1.

Applicants respectfully traverse the rejection of claims 6-9 under 35 U.S.C. §103(a) as being unpatentable over *Ferstenberg*. A *prima facie* case of obviousness has not been established.

Independent claims 6 and 7, though of different scope than claim 1, are allowable over *Ferstenberg*, for at least the same reasons as claim 1. Claim 8 depends from

claim 7, and is thus allowable over *Ferstenberg*, for at least the same reasons as claim 7.

Furthermore, the Examiner alleges, “[e]scrow accounts and escrow agents are very well known in the art. The examiner takes official notice of this fact” (Office Action at page 10). The Examiner further states, “it is commonplace to use a third party (escrow agent) when dealing with sales of items subject to contract conditions” (Office Action at page 10).

The proposition cited by the Office Action is not applicable because the Office Action has not demonstrated that the elements sought to be combined are “known.” MPEP § 2144.03 states, “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” Instead, the Examiner has made generalized statements without any documentary evidence to support it.

Applicants traverse the Examiner’s taking of “Official Notice,” noting the impropriety of this action, as the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” See *id.* Applicants submit that “[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is ‘basic knowledge’ or ‘common sense.’” *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicants submit that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made," or else withdraw the rejection. See MPEP § 2144.03.

Here, the Examiner appears to rely upon alleged what is "commonplace" within the art. As stated in M.P.E.P. § 2144.03, such assertions are not proper because the Examiner has not demonstrated that the asserted facts are well-known or capable of instant and unquestionable demonstration as being well-known in the art. Therefore, the rejection of claims 6 and 7 improper.

Claim 9, as amended, recites an information processing method including "maintaining a first site map indicating associations between web pages linked to the first web page, wherein the buyer information processing apparatus jumps to a different web page based on an operation performed on the first web page and the first site map." *Ferstenberg* fails to disclose at least the claimed maintaining a first site map.

Ferstenberg discloses, "agents conduct negotiations by exchanging electronic messages with the intermediary" (col. 12, lines 43-45). *Ferstenberg* further discloses, "the intermediary actively initiates all message exchanges while each e-agent waits passively for and responds to messages from the intermediary" (col. 14, lines 28-30). *Ferstenberg* does not disclose "maintaining a first site map . . . wherein the buyer information processing apparatus jumps to a different web page based on an operation performed on the first web page and the first site map," as recited in claim 9.

Accordingly, *Ferstenberg* fails to render subject matter of claims 6-9 obvious.


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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